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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,671

10/01/2003

Robert L. Goldsmith

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EXAMINER

MENON, KRISHNAN S

ART UNIT

PAPER NUMBER

1723

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/676,671

Applicant(s)

GOLDSMITH ET AL.

Examiner

Krishnan S. Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8 is/are allowed.
- 6) ☒ Claim(s) 2-13, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 2-13, 17 and 18 are pending in the RCE/supplemental amendment of 1/2/07.

Terminal Disclaimer

The terminal disclaimer filed on 11/16/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 10/852,976 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5,9-13, 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The negative limitation, "...circulated permeate flows substantially through the entire length of the permeate chambers without encountering an egress to an external surface of the membrane element ...", in independent claims 17 and 18 does not

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appear to have adequate support in the specification or claims as originally filed. See MPEP 2173.05(i) about negative limitations.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 18 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 9 of copending Application, No. 10/698,267. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of both applications recite similar structural elements, the differences in the limitations are only of intended use, the '267 application reciting passing a sweep fluid through the permeate in place of the recirculation of the permeate in the instant claims.

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These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 2-5, 9-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rajnik'436 in view of Goldsmith (US 4,781,831).

Claim 17: Rajnik teaches a cross-flow membrane device (see figures) having a ceramic monolith support (column 3 lines 55-60), plurality of longitudinal passages for feed and permeate (column 4 lines 1-10), a membrane coated on the feed side walls (column 6 lines 14-25), permeate conduits in the monolith (see figures, column 4 lines 1-17), and means for permeate introduction, withdrawal and recirculation (the parallel set of channels are for feed and permeate as in column 4 lines 39-47 and column 5 lines 30-48; membrane processes such as gas separation and pervaporation often require sweep gas or recirculation of the permeate-side gas for reducing the partial pressure or vapor pressure of the permeate: "the egress conduits can be equipped with means for providing second gas or liquid ... can be sweep gas ..."; column 6 lines 38-43). The means-plus-function language in claim would invoke 35 USC 112, sixth paragraph, and accordingly, the claimed means would be what is specified or

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equivalents thereof. Applicant's specification page 6 middle paragraph describes such means as "... simple modifications to the monolith structure and installing the membrane devices within housings with simple connections for permeate flow circulation ...". Such provisions of housing and connections would be implied in the teaching of Rajnik. "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976). The driving force in claim 16 is also considered as "means plus function" limitation, the driving force recited in the specification being the recirculation of the permeate stream, or equivalent thereof; the use of sweep gas in the reference would be an equivalent. These limitations of recirculation or driving force are also intended use, which the teaching of the reference is capable of, and therefore, not patentable.

Alternately, with respect to the housing and connections as in the instant claims, Goldsmith teaches a ceramic monolith membrane in a housing with inlet and outlet connections. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Goldsmith in the teaching of Rajnik because Goldsmith does not provide the details of how to make the device into usable form with the various connections, and one would use the teaching of Goldsmith because Goldsmith teaches providing low-pressure drop packing material as mechanical support for the filter and the filtrate conduits in assembly (see column 4 lines 32-36 and claim 18)

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With respect to the negative limitation, "... permeate flows substantially through the entire length ...without encountering an egress to an external surface ...", Rajnik teaches that the monolith element can be equipped with means for providing sweep gas, etc., in column 6 lines 40-43, and the egress conduits are optimally provided to reduce permeate back-pressure in column 5 lines 30-48. Rajnik does not limit the number and position of the egress conduits, and it can be one or more. Thus there is sufficient teaching in Rajnik to one of ordinary skill in the art to provide the egress conduits at the ends of the element as claimed, to facilitate permeate recycle or sweep gas flow. More over, providing structure to have a sweep gas flow in gas separation membrane elements is well known in the art.

Claims 2 and 3: single monolith or monolith segments: column 4 lines 18-36

Claim 4: ultrafiltration or microfiltration – see column 5 lines 15-17.

Claim 5: annular space between the membrane device and the housing – see figures of the Goldsmith reference.

Claim 9: Means for permeate introduction and withdrawal are ducts: this is implicit in Rajnik in view of Goldsmith. In re Preda.

Claim 10: reduced area in permeate chambers – see column 4 lines 14-16.

Claims 11, 12, 13: area reduced during fabrication process: product by process limitation; it is immaterial for a product claim as to when the modification was done. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

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process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re *Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Filling the chambers with packing material, as in claim 13, is taught by Goldsmith – see column 4 lines 32-36.

2. Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rajnik’436 in view of Goldsmith (US 4,781,831), with Vane et al (US 2004/0000521) as further evidence.

Rajnik in view of Goldsmith teaches the method of separating a feed stock as claimed. With respect to the circulation of a portion of the withdrawn permeate through the internal permeate conduits, applications such as gas separation and pervaporation require a driving force such as reduction in partial or vapor pressure in the permeate channels, which include circulation of a sweep gas, or recirculation of the permeate stream. Teaching of the use of the membrane device in the teaching of Rajnik in view of Goldsmith implies such sweep gas or permeate recirculation. For evidence, see Vane, which teaches recirculation of the permeate stream in pervaporation or membrane distillation process (abstract, figures and paragraphs 75 and 89).

With respect to the negative limitation, “... permeate flows substantially through the entire length ...without encountering an egress to an external surface ...”, Rajnik teaches that the monolith element can be equipped with means for providing sweep gas, etc., in column 6 lines 40-43, and the egress conduits are optimally provided to reduce permeate back-pressure in column 5 lines 30-48. Rajnik does not limit the

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number and position of the egress conduits, and it can be one or more. Thus there is sufficient teaching in Rajnik to one of ordinary skill in the art to provide the egress conduits at the ends of the element as claimed, to facilitate permeate recycle or sweep gas flow. Moreover, providing structure to have a sweep gas flow in gas separation membrane elements is well known in the art.

Allowable Subject Matter

Claims 6-8 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The closest references, Goldsmith and Rajnik do not teach a flow resistance material filling the annular space between the membrane device and the housing. Even if Goldsmith teaches a filling material as support in the permeate conduits within the membrane device, there is no teaching or suggestion to extend this packing to the annular space between the membrane device and the housing.

Response to Arguments

Applicant's arguments filed 12/28/06 have been fully considered but they are not persuasive.

Response to arguments regarding the Rajnik reference is provided with the rejection.

Response to the argument regarding the negative limitation: even if applicant's disclosed figures show egress conduits only at the ends of the element, there is no

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support for the recited negative limitation; the disclosure does not limit the egress conduits to just at the ends; and this negative limitation appears to be added for the purpose of overcoming the reference.

The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. [MPEP 2173.05(i)].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Handwritten signature of Krishnan S Menon and the date 1/11/07.

Krishnan S Menon
Primary Examiner
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